

#### **IV. REMARKS**

##### **Status of the Claims**

Claims 1 and 5 are amended and new claims 31 and 32 are added. Claims 1-13, 31, and 32 are presented for further consideration.

##### **Summary of the Office Action**

Claims 1-13, 9 stand rejected under 35USC103(a) on the basis of the cited reference Wong et al, U.S. Patent No. 5,881,103 in view of the cited reference Schwartz, U.S. Patent No. 4,823,391. The Examiner is respectfully requested to reconsider her rejection in view of the above amendments and the following remarks.

##### **Discussion of the Cited Reference**

It is acknowledged that this office action effectively withdraws the application from the appeal process initiated by applicant and reopens prosecution. In response to the issues raised on appeal, the Examiner has admitted that the primary reference Wong, et al does not disclose an auxiliary device for a mobile telephone that has a microcontroller. In addition it is admitted that the auxiliary device of Wong is not capable of two-way communication. The Examiner relies on the reference Schwartz to remedy these deficiencies in the disclosure of Wong.

Wong et al, discloses a method in which a radio telephone device has access to the audio parameters of an auxiliary device constructed for use with telephone. The parameters are stored on the auxiliary device in a memory block 220

directly readable by the interface 115 of the radiotelephone 110. This is a passive participation on the part of the auxiliary device, which is in contrast to the system of this invention in which, through a microcontroller in the auxiliary device, two way communication provides an interactive transaction between the electronic device and the auxiliary device.

The cited reference Schwartz describes a sound reproduction system. The system of Schwartz is designed to couple the speakers of an audio system with the environment in which the speakers reside. Sonar sensors are mounted in the speakers to generate signals from which settings of the digital pre-amplifier of the system may be adjusted. The function of the environmental coupling system is described as follows:

"The coder-decoder, while continuously connected to the sonar sensors, is preferably activated periodically when the system is operating to process the information received from the sonar modules. The speaker cabinet coder/decoder microprocessor combination is preferably designed to activate the sonar units in a predetermined sequence. The return signal detected by the sonar unit can be decoded to provide information about the distance to the nearest solid object, its percentage of obstruction of the view angle, and the absorption properties of the surfaces at predetermined frequencies. The multiple signals from the sonar units on each speaker cabinet can thereby be de-coded and analyzed to provide a spectral profile of the environment and an acoustic measurement of the loudspeakers, audio reproduction characteristics in that environment.

This sensing and processing capability is built into the speaker cabinet or may be provided as an add on module. It is suggested that the system be used in an interactive mode as stated below:

"Thirdly, the present system can be utilized in an interactive mode to modify the acoustic environment and/or the signal itself. Either by direct action on front panel controls, or by use of a personal computer attached to the pre-amplifier, the listener can personally modify, over a wide range, the signal processing parameters. These features might include EQ, echo, reverb, chorusing, harmonizing, mixing and panning. Such features will be especially useful when one of the audio pre-amplifier input signals is a musical instrument, in addition to the pre-recorded, or broadcast source. For example, an amateur musician could play along with a stereo simulcast of a live performance without sounding "tacked-on" to the broadcast signal."

From the above excerpts from the reference Schwartz, it is ascertained that the system described in this reference is a complex audio system for use in professional audio reproduction systems designed for the audiofile.

Although there is a need in Schwartz for a processor to analyze the signals from the sonar sensors and two way communication is established between the speakers and the pre-amplifier of the system, there is no indication that any preset audio parameters are stored in the speakers for use by the system. The processor of Schwartz requires significant processing capability (a personal computer is suggested) in order to provide an environmental spectrum from the signals from the sonar sensors. Communications are designed for a real time reading of the sonar sensor signals to provide instantaneous environmental coupling.

There is no indication that this system would be in any way adaptable to or useful in an auxiliary device for a mobile telephone. The speakers of this system are an integral

part of the system and not an auxiliary device for optional use. The complexities of the system of Schwartz are not adaptable to an auxiliary device, such as a hands free accessory, as contemplated in the subject application.

### **The Issue of Obviousness**

As stated in MPEP Sec. 2142:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

There is nothing in the cited references that would lead a person skilled in the art to combine the teachings of these references. Although each deals with sound reproduction, the approach of the reference Wong is at one end of the technical spectrum of such systems and the reference Schwartz is at the other. A person skilled in the art would not seek technology from a complex audio system, when attempting to provide operating parameters for a mobile telephone accessory.

Further, it does not appear that the Examiner has considered the claims as a whole, but has dismantled the claims and

pursued a search for the individual features. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:

**"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."**

Applicant submits that the only link between the teachings of Schwartz and Wong is the subject invention. The combination of these teachings, therefore, is beyond the scope of 35USC103.

The above arguments apply equally to the rejected dependent claims.

For all of the above reasons, it is respectfully submitted that all of the claims, now present in the application, are novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.



Respectfully submitted,

Janik Marcovici  
Reg. No. 42,841

Date

Perman & Green, LLP  
425 Post Road  
Fairfield, CT 06824  
(203) 259-1800  
Customer No.: 2512

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